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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P1535US01

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Signature Diana C. Anderson

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name Diana C. Anderson

Application Number

09/981,556

Filed

October 17, 2001

First Named Inventor

Arnold G. Slezak

Art Unit

3729

Examiner

Anthony Tugbang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 38,794

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Mitchell K. McCarthy

Typed or printed name

(405) 232-0621

Telephone number

11/21/2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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PATENT
Dkt. P1535US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Arnold G. Slezak**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **09/981,556** Group Art: **3729**
Filed: **October 17, 2001** Examiner: **Anthony Tugbang**
For: **METHOD TO REDUCE SERVO PATTERN RUNOUT ON A
PREWRITTEN DISC**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT ESTABLISHED A *PRIMA FACIE* CASE OF ANTICIPATION OVER KUROBA '990 BY FAILING TO SUBSTANTIATE EVIDENCE THAT IT IDENTICALLY DISCLOSES ALL THE RECITED FEATURES OF INDEPENDENT CLAIM 1

The present embodiments contemplate writing servo information to a plurality of discs in a servo track writer (STW), then removing multiple ones of the plurality from the STW and placing them into a disc drive to form a disc stack. In so doing, the plurality of discs are biased in a direction along a *common angular reference* in the STW. The multiple ones of the plurality are then placed in the disc drive with the *angular references* disposed symmetrically around the motor, and then each disc is biased against the motor in a direction of its respective *angular reference*.

These embodiments according to the language of claim 1 require:

placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular reference axis of each disc, around a motor hub, the prewritten discs placed with respect to each other disposing the angular reference axes symmetrically around the motor hub; and

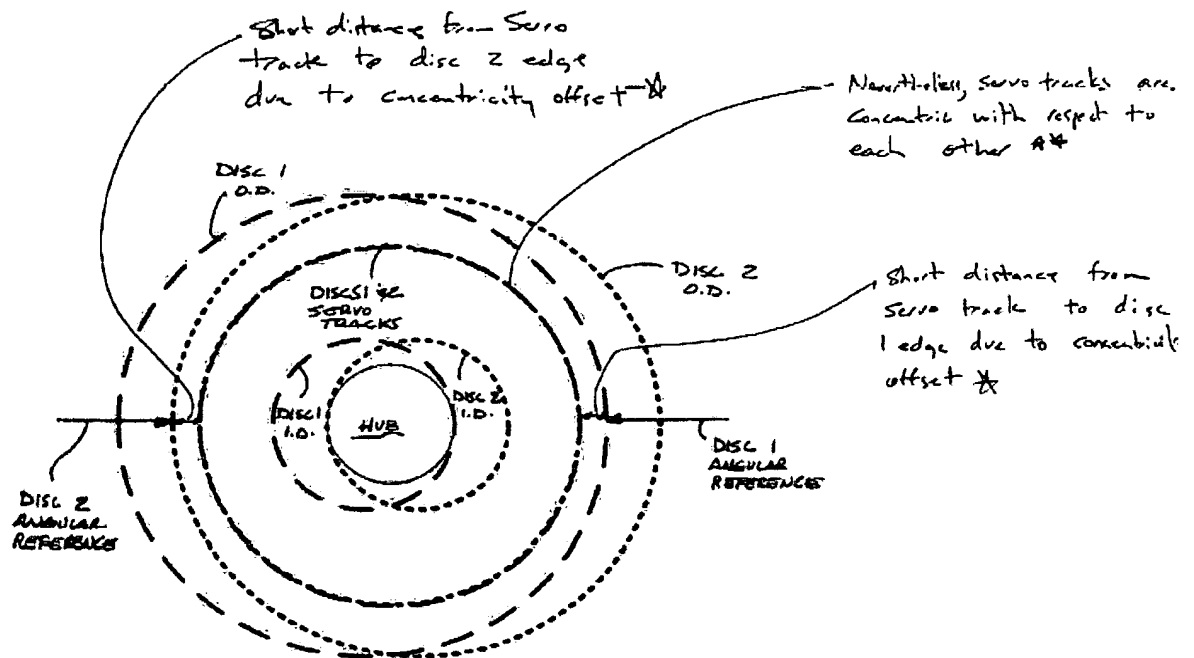
biasing each disc in a direction of the respective angular reference axis to concentrically align the servo tracks of a first disc of the prewritten discs with the servo tracks of a second disc of the prewritten discs.
(excerpt of claim 1, emphasis added)

Throughout the last two years of prosecution of this case, until the final Office Action of 8/21/2006, there has been no question that the claim language *servo tracks that are offset* clearly and plainly means that the servo tracks are nonconcentric with respect to the disc center. The skilled artisan readily understands that nonconcentric servo tracks are the natural result of biasing the discs in the STW, and the subject matter of both the present application and the cited reference. However, in the final rejection of 8/21/2006 the Examiner for the first time posited a construction of the term *offset* as meaning that the servo tracks are “offset” because they are disposed in one direction while the angular reference axis is disposed in a different direction. Applicant attempted to amend the claims solely in order to more particularly distinguish over the Examiner’s new claim construction, by claiming *servo tracks that are offset concentrically in relation to a center of each disc....* The Examiner’s determination that the proposed amendment raises new issues requiring more searching is inappropriate in light of the plain meaning of the original term, the statements already in the record about the term’s meaning, the fact that the amendment was responsive to the Examiner’s new claim construction at final rejection and the fact that the amendment does clarify the issue for appeal. Applicant believes the Panel should reopen prosecution if for no other reason than to permit entry of the clarifying amendment to place the case in better condition for appeal in accordance with Rule 1.116.

In any event, the claim language clearly recites the *servo tracks are offset in relation to a common angular reference axis of each disc....* Thus, the *angular reference axis* is a characteristic of the disc. For example, without limitation, the servo tracks can be offset in relation to an angular reference corresponding to a particular timing mark of each disc (see Applicant’s Response of 11/30/2004 ppg. 13-15). Because the plurality of discs have servo tracks that are offset in relation to a common angular reference axis, such as all servo tracks being offset in relation to the zero timing mark of each disc, the plurality of discs are substantially identical with respect to the offset orientation of the servo tracks.

Importantly though, because the offset is in terms of nonconcentricity in relation to the angular reference, after the servo tracks are written to a disc only one angular reference

is defined for that disc. Exhibit A has twice been introduced in the record for illustrative purposes (see Applicant's Response of 11/30/2004; Applicant's Response of 10/20/2006). It illustrates embodiments of the present invention used to construct a two-disc stack. Particularly, the discs have servo tracks (one shown for each disc) *that are offset in relation to a common angular reference axis of each disc*. The discs are angularly disposed around the hub with the *angular references* disposed 180 degrees apart, and then the discs are biased against the hub in directions along the respective *angular references*. The *angular reference axis* is depicted for each disc as being the radial axis along which the offset servo tracks are most closely disposed adjacent the disc edge. When the identically written discs are thus angularly disposed and biased in directions of the respective angular references, the servo tracks of the discs are concentrically disposed with respect to each other.



However, the Examiner repeatedly construed the term *angular reference axis* not as a characteristic of the disc at all, contrary to the express claim language, but rather as the direction of any arbitrary external biasing force acting on the disc:

The "common angular reference axis" for each disc can be read as any axis along each disc used in biasing or balancing the disc...each disc has more than one "common angular reference axis" or angular reference axes, which

can be used in biasing or balancing the disc in relation to the servo tracks
(Office Action of 8/21/2006, ppg. 3 and 6; Office Action of 3/1/2006 pg. 4).

Applicant has pointed out in the record that the Examiner's claim construction is unreasonably broad because it is contrary to the ordinary meaning of the claim phrase *placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular reference axis of each disc*, thereby effectively ignoring explicitly recited claim language. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997) (see Applicant's Response of 10/20/2006 pg. 11)

But even considering for a moment the Examiner's construction of *angular reference axis* to mean "direction of biasing" (which Applicant traverses as unreasonable), Applicant has pointed out in the record that the Examiner has not substantiated any credible explanation as to how discs that are biased in different directions can be reasonably viewed as anticipating *servo tracks that are offset in relation to a common angular reference axis of each disc*. For example, in a two disc stack (Exhibit A) the directions of biasing are 180 degrees out of phase; in a three disc stack (Exhibit B, see Applicant's Response of 11/30/2004; Applicant's Response of 10/20/2006) the directions of biasing are 120 degrees out of phase. Applicant believes the Panel should reopen prosecution if for no other reason than to substantiate how biasing in different directions anticipates the *common angular reference axis*.

Applicant has also pointed out in the record, without rebuttal by the Examiner, that the Examiner's claim construction is unreasonable because it relies on a mischaracterization of what Kuroba '990 actually discloses (see Applicant's Response of 10/20/2006 ppg. 11-12; Applicant's Response of 5/31/2006 ppg. 10-11; Applicant's Response of 11/22/2005 ppg. 17-18):

Kuroba discloses a method comprising: placing prewritten discs 20, each characterized by servo tracks that are offset in relation to a common angular reference axis around a motor hub (spindle 21)....
(Office Action of 8/21/2006 pg. 3; Office Action of 3/1/2006 pg. 4)

Actually, Kuroba '990 expressly discloses:

If a plurality of disk media 20 are stacked, a balance control can be attained by the following manner...However, in a case of the data surface servo system, the servo track writing (STW) must be performed individually for the groups of disks in which the contact position is changed for the respective groups.
(Kuroba '990, col. 8 lines 31-41, emphasis added)

The skilled artisan recognizes from a plain reading of Kuroba '990 that it does not identically disclose *placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular reference axis of each disc* as claimed. Rather, Kuroba '990 discloses the discs each having servo tracks that are offset in relation to different angular references that are defined by the directions in which they ultimately will be biased in the disc drive. In other words, the plurality of discs in Kuroba '990 are not substantially identical with respect to the offset of the servo tracks, as in the present embodiments as claimed that recites *servo tracks that are offset in relation to a common angular reference axis of each disc*.

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. This case is not in condition for appeal due to the unresolved factual issues that the Examiner's claim construction is unreasonably broad, that even in the unreasonably broad construction the Examiner has not substantiated evidence that the servo tracks are *offset in relation to a common angular reference*, and that the unreasonably broad construction relies on a mischaracterization of what the cited reference actually discloses. This case is not ready for appeal until these factual issues are resolved by the Examiner either withdrawing the rejection or substantiating it factually in the record. Applicant prays the Panel will re-open prosecution of this case for that purpose.

Respectfully submitted,

By: 

Mitchell K. McCarthy, Registration No. 38,794
Randall K. McCarthy, Registration No. 39,297
Fellers, Snider, Blankenship, Bailey and Tippens, P.C.
100 N. Broadway, Suite 1700
Oklahoma City, Oklahoma 73102
Telephone: (405) 232-0621
Facsimile: (405) 232-9659